



**UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/119,187	07/20/98	WARREN	C 98-15

RONALD A KRASNOW  
SYMYX TECHNOLOGIES  
3100 CENTRAL EXPRESSWAY  
SANTA CLARA CA 95051

IM22/0425

EXAMINER

LEADER, W

ART UNIT	PAPER NUMBER
----------	--------------

1741

DATE MAILED:

04/25/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/119,187

Applicant(s)

Warren et al

Examiner

William Leader

Group Art Unit

1741

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 2/8/2000 with a COM dated 1/28/2000.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 19-22, 24 and 38-48 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 19-22, 24 and 38-48 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_.

## Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 6
- ☐ Notice of References Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

Office Action Summary

Art Unit: 1741

Receipt of applicant's response of February 8, 2000, with a certificate of mailing dated January 28, 2000, is acknowledged. Claims 1-18, 23, 25-37 have been canceled. New claims 38-48 have been added.

Receipt of the formal drawings is acknowledged.

The disclosure is objected to because of the following informalities: at page 12, line 18, the symbol after "1000-2000" is not recognizable..

Appropriate correction is required.

Claims 19-22, 24 and 38-48 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As noted above, claim 23 has been canceled. Claim 24, as written, still depends on claim 23. Consequently, its scope is indefinite.

Applicant has amended claim 19, line 5 to recite the step of delivering at least one source material (singular). Claim 19, line 7 refers to "said source materials" (plural). This expression lacks correct antecedent basis since line 5 requires only one material.

Claim 19, line 6 recites that the at least one source materials is deposited at

Art Unit: 1741

predetermined "locations" (plural). This limitation requires that even if only one source material is delivered, it must be deposited at more than one location. Claim 19, line 7-8 recite depositing on a given electrode (singular). This limitation appears to be inconsistent with the limitation of line 6 since a given electrode would be at only one location, not a plurality of locations. The claim would be clearer if it recited that each predetermined location to which the source material was delivered corresponded to one of the individually addressable electrodes.

Claim 19, lines 7-8 recite that the step of depositing on a given electrode produces a library of inorganic materials. It is not clear how one step of depositing produces a "library" of materials if "library" is interpreted as used in the specification. (Page 8, lines 3-5 state that "The deposition of materials on the above described electrode arrays to make a library of an equal number of compositions is accomplished by the electrodeposition of species from solution using standard electrochemical methods.") It appears that the step of depositing must be carried out a plurality of times, each time on a different one of the individually addressable electrodes, to create a library of deposited inorganic materials.

Claim 19, line 10 recites the step of "screening said library of inorganic materials for a useful property". The scope of "useful property" is indefinite. A property useful in one application would not necessarily be useful in a different application. It would be clearer if the claim recited that a common selected

Art Unit: 1741

property of each deposit in the library was analyzed.

Newly submitted independent claims 40 and 41 recite the step of delivering a mixture of source materials to predetermined locations on the array, but don't require that the source materials be delivered to an addressable electrode. Lines 6-7 recite depositing source materials on a given electrode. In order for the deposition to occur on an electrode, it appears that the claims should recite that the predetermined locations correspond to an electrode.

Claims 40 and 41, lines 8-9 recite creating a library of semiconductor-containing materials "within" said array. The use of "within" appears to be inconsistent with lines 6-7 which recite depositing "on" a given electrode. To be consistent, it appears that line 9 should recite creating the library --on-- said array.

Claims 40 and 41, line 10 recites the step of "screening said library of semiconductor-containing materials for catalytic property". The scope of "catalytic property" is indefinite. While a material may have a composition or other property that is catalytic to one process, the same composition may not be catalytic to other processes. As in claim 19, it would be clearer if the claim recited that a common selected property of each deposit in the library was analyzed.

Claim 46, line 2 refers to "the counter anions". This expression lacks antecedent basis.

Art Unit: 1741

Claims not individually addressed are rejected for the reasons given with respect to the claim or claims on which they depend.

Claims 19-22, 24, 38, 39 and 41-48 rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 19, line 8 recites the deposition of inorganic materials, while claim 41 recites the deposition of metal-containing materials. Example 1, shows the deposition of a Pt-Ru alloy. The inorganic material of claim 19 and the metal-containing material of claim 41 read on metal alloys. It is generally accepted that metals are electrolytically deposited from a solution at the cathode. However, applicant's specification describes the individually addressable electrode arrays as being a part of the anode assembly (page 10, lines 4-5). This description appears to be inconsistent with the deposition of inorganic materials or metal-containing materials as now recited in claim 19. May the electrode array be a part of the cathode assembly as well as the anode assembly?

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 1741


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William Leader, whose telephone number is (703) 308-2530. The examiner can normally be reached Mondays-Fridays from 7:30 AM to 3:00 PM eastern time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kathryn Gorgos can be reached at (703) 308-3328. The fax phone number for *official* after final faxes is (703) 305-3599. The fax phone number for all other *official* faxes is (703) 305-7718. Unofficial communications to the Examiner should be faxed to (703) 305-7719.

Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is (703) 308-0661.

William Leader:wtl  
April 21, 2000

  
Kathryn Gorgos  
Supervisory Patent Examiner  
Technology Center 1700